REMARKS

Forty-three claims are pending in the present Application. Claims 1-43 currently stand rejected. Claims 1, 8, 15, 17, 21, 28, 35, 37, 41, and 43 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

35 U.S.C. § 103

On page 3 of the Office Action, the Examiner rejects claims 1-5, 7-8, 20-25, 27-28, and 40-43 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,441,754 to Wang et al. (hereafter Wang) in view of U.S. Patent No. 3,694,581 to Fletcher et al. (hereafter Fletcher). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

> "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations" (emphasis added).

The initial burden is therefore on the Examiner to establish a *prima facie* case of

obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of independent claims 1, 21, 41, and 43 Applicant responds to the Examiner's §103 rejections as if applied to amended independent claims 1, 21, 41,and 43 which are now amended to recite *"said data transcoding procedure being triggered by said storage manager to begin whenever said available storage space in said storage medium is less than at least one predetermined storage-space threshold value,"* which are limitations that are not taught or suggested either by the cited references, or by the Examiner's citations thereto.

Wang teaches a "set top box" that first "decodes" digital video data and then "re-encodes" the digital video data before storing the digital video data (see column 2, lines 47-63). In contrast, Applicant's invention is directed toward an audio/video recorder device. Applicant submits that Wang fails to disclose "*selectively*" transcoding "*specified segments*" of A/V data, as claimed by Applicant.

In particular, Applicant submits that Wang nowhere teaches or suggests monitoring "*available storage space*" in a local memory, and responsively triggering a transcoding operation to reduce the amount of stored data "*whenever said available storage space in said storage medium is less than at least one predetermined storage-space threshold value,*" as claimed by Applicant. Nowhere does Wang mention utilizing the concept of a "storage-space threshold value."

Furthermore, Applicant submits that Wang is directed to encoding and then re-encoding incoming data, and fails to disclose "*a mediate mode during*

which said transcoding procedure occurs when said information is not currently being received by said electronic device," as claimed by Applicant.

On page 4 of the Office Action, the Examiner concedes that "Wang fails to disclose selectively activating a data transcoding procedure . . . whenever available storage space in storage medium is less than at least one predetermined storage-space threshold value." Applicant concurs. The Examiner then points to Fletcher to purportedly remedy these deficiencies in Wang.

Applicant respectfully traverses, and submits that the Examiner has inaccurately interpreted the teachings of Fletcher. In Fletcher, an apparatus is disclosed "in which only those samples of the raw data are selected for transmission which have a first difference (slope) that exceeds an exponentially decaying threshold function relative to a bias" (emphasis added) (see Abstract).

Fletcher therefore teaches a technique that decreases the total amount of data flow by entirely omitting certain data samples. However, Applicant submits that simply omitting entire data samples is not a "data transcoding procedure," as claimed by Applicant. As support for the foregoing statement, Applicant directs the Examiner to pages 18 and 19 of the Specification, which provides numerous specific examples of transcoding procedures that completely alter the data format of the subject video and audio data.

On page 4 of the Office Action, the Examiner specifically cites column 5, lines 10-35, of Fletcher as support for the foregoing rejections. Applicant respectfully traverses. Column 5, lines 10-35, of Fletcher discloses a "buffer fullness counter" that is utilized only "to alter the operation of function generator

30 to provide a function to the comparator 20 that decays more slowly or starts at a higher level . . ." (emphasis added). In particular, Fletcher discloses that "the rate at which the function of the generator 30 decreases can be increased" (emphasis added). Fletcher is therefore limited to adjusting a "rate," and completely fails to teach actively triggering a data transcoding procedure "to begin," as now claimed by Applicant.

Applicant further submits that the "buffer fullness counter" taught by Fletcher is used only to adjust the rate of an ongoing data transmission that is already in progress (see column 5, lines 10-35). Applicant submits that Fletcher nowhere teaches any sort of data transcoding procedure that is affirmatively "triggered . . . to begin" (emphasis added), as now recited in amended claims 1, 21, and 42-43. For at least the foregoing reasons, Applicant submits that claims 1, 21, 41, and 43 are not anticipated by the teachings of Wang and Fletcher.

With regard to claim 42, "means-plus-function" language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 discussed above. Applicant therefore incorporates those remarks by reference with regard to claim 42. In addition, the Courts have frequently held that "means-plus-function" language, such as that of claim 42, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicant respectfully submits that, in light of the substantial differences between the teachings of

Wang and Applicant's invention as disclosed in the Specification, claim 42 is therefore not anticipated or made obvious by the teachings of Wang.

Regarding the Examiner's rejection of dependent claims 2-5, 7-8, 20, 22-25, 27-28, and 40, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claims 2-5, 7-8, 20, 22-25, 27-28, and 40 so that these claims may issue in a timely manner.

Furthermore, the Examiner cites column 7, lines 9-15 and 38-43, of Wang in support of the rejections of claims 8 and 28. Applicant respectfully traverses. Applicant submits that Wang nowhere discloses a storage manager that "*chooses*" from several different techniques to implement an "immediate mode," as claimed by Applicant. Applicant also submits that Wang is limited to a decode-encode procedure, and nowhere discloses a "*recording parameter alteration technique,*" as disclosed and claimed by Applicant. In addition, the cited section of Wang fails to teach a "previously-stored data transcoding technique" that occurs while other input data is being simultaneously recorded, as in Applicant's claimed "immediate mode."

For at least the foregoing reasons, the Applicant submits that claims 1-5, 7-8, 20-25, 27-28, and 40-43 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper.

The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 1-5, 7-8, 20-25, 27-28, and 40-43 under 35 U.S.C. § 103.

On page 6 of the Office Action, the Examiner rejects claims 6, 10, 26, and 30 under 35 U.S.C. § 103 as being unpatentable over Wang and Fletcher in view of U.S. Patent No. 6,768,864 to Kimura et al. (hereafter Kimura). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 6, 10, 26, and 30, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claims 6, 10, 26, and 30 so that these claims may issue in a timely manner.

In addition, the Court of Appeals for the Federal Circuit has held that "obviousness cannot be established by combining the teachings of the prior art to

produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicant submits that the cited references do not suggest a combination that would result in Applicant's invention, and therefore the obviousness rejection under 35 U.S.C §103 is improper.

For at least the foregoing reasons, the Applicant submits that claims 6, 10, 26, and 30 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 6, 10, 26, and 30 under 35 U.S.C. § 103.

On page 8 of the Office Action, the Examiner rejects claims 9 and 29 under 35 U.S.C. § 103 as being unpatentable over Wang and Fletcher in view of U.S. Patent No. 5,270,829 to Yang (hereafter Yang). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 9 and 29, for at least the reasons that these claims are dependent from respective independent

claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claims 9 and 29 so that these claims may issue in a timely manner.

With further regard to the rejections of claims 9 and 29, the Examiner states that Wang discloses a mediate mode transcoding "*as part of a background process.*" Applicant respectfully traverses. Applicant submits that Wang nowhere mentions any type of mediate mode transcoding that occurs as "*a background process,*" as claimed by Applicant. On page 7 of the Office Action, the Examiner concedes that "Wang fails to disclose scheduling of mediate transcode from storage medium." Applicant concurs.

The Examiner then points to Yang to purportedly remedy the foregoing deficiencies in Wang. Yang is directed toward creating a "reserve-recording" in which a system user is responsible for affirmatively and specifically "setting the current time and storing the inputted reserve-recording and reserve-playback times respectively" (see column 2, lines 4-6). However, Applicant submits that Yang nowhere discloses a storage manager that controls a mediate mode in which "*said electronic device responsively turning itself on at an arbitrary time when a system user is unlikely to be utilizing said electronic device, said electronic device then transcoding said one or more specified stored items and turning itself off when finished,*" as claimed by Applicant.

For at least the foregoing reasons, the Applicant submits that claims 9 and 29 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 9 and 29 under 35 U.S.C. § 103.

On page 9 of the Office Action, the Examiner rejects claims 11-13, 16-18, 31-33, and 36-38 under 35 U.S.C. § 103 as being unpatentable over Wang and Fletcher in view of U.S. Patent No. 6,577,812 to Kikuchi et al. (hereafter Kikuchi). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 11-13, 16-18, 31-33, and 36-38, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicant therefore respectfully requests

reconsideration and allowance of dependent claims 11-13, 16-18, 31-33, and 36-38 so that these claims may issue in a timely manner.

With further regard to the rejections of claims 11 and 31, the Examiner states that Kikuchi discloses a "*predetermined storage-space threshold that is selectable by a system user,*" as claimed by Applicant. Applicant respectfully traverses. The Examiner states that Kikuchi teaches displaying "the remaining recording time which means it will inform if storage medium is less than predetermined storage space."

Therefore, by the Examiner's own admission, Kikuchi teaches a changeable "remaining recording time" and not a fixed "*predetermined storage space threshold,*" as claimed by Applicant. Furthermore, Applicant submits that the remaining recording time is not "*selectable by a system user,*" as expressly claimed by Applicant. For the foregoing reasons, Applicant therefore submits that Kikuchi *teaches away* from Applicant's invention. A prior art reference which teaches away from the presently claimed invention is "strong evidence of nonobviousness." In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed. Cir. 1987).

With regard to the rejections of claims 12-13 and 32-33, the Examiner cursorily states that these claims "are rejected for the same reasons as discussed in the correspond claim 11 above." Applicant submits that claims 12-13 and 32-33 recite additional limitations that have not been addressed by the Examiner. Applicant therefore submits that claims 12-13 and 32-33 have not received an

adequate examination, and respectfully requests the Examiner to address the specific claim limitations in claims 12-13 and 32-33.

For at least the foregoing reasons, the Applicant submits that claims 11-13, 16-18, 31-33, and 36-38 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 11-13, 16-18, 31-33, and 36-38 under 35 U.S.C. § 103.

On page 11 of the Office Action, the Examiner rejects claims 14-15, and 34-35 under 35 U.S.C. § 103 as being unpatentable over Wang, Fletcher, Kikuchi, and Yang. The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 14-15 and 34-35, for at least the reasons that these claims are depend from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or

suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claims 14-15 and 34-35 so that these claims may issue in a timely manner.

With further regard to the rejections of claims 14 and 34, the Examiner states that Kikuchi discloses a "*predetermined storage-space threshold that is selectable by a system user,*" as claimed by Applicant. Applicant respectfully traverses. The Examiner states that Kikuchi teaches displaying "the remaining recording time which means it will inform if storage medium is less than predetermined storage space." Therefore, by the Examiner's own admission, Kikuchi teaches a changeable "remaining recording time" instead of a fixed "*predetermined storage space threshold,*" as claimed by Applicant.

With regard to the rejections of claims 15 and 35, the Examiner cursorily states that these claims are "rejected for the same reason as discussed in the correspond claim 14 above." Applicant submits that claims 15 and 35 recite additional limitations that have not been addressed by the Examiner. For example, claims 15 and 35 recite "*system-user preference selections that establish a transcoding selection priority that is based upon at least one of a data-type hierarchy system and a data-recording chronology system, said data-type hierarchy system ranking said specified segments according to selected data characteristics, said data-recording chronology system ranking said specified segments from an oldest recording to a newest recording according to respective recording dates and recording times.*" Applicant therefore submits that claims 15

and 35 have not received an adequate examination, and respectfully requests the Examiner to address the specific claim limitations in claims 15 and 35.

For at least the foregoing reasons, the Applicant submits that claims 14-15 and 34-35 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 14-15 and 34-35 under 35 U.S.C. § 103.

On page 13 of the Office Action, the Examiner rejects claims 19 and 39 under 35 U.S.C. § 103 as being unpatentable over Wang, Fletcher, Kikuchi, and Kimura. The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 19 and 39, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or

suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claims 19 and 29 so that these claims may issue in a timely manner.

With further regard to the rejections of claims 19 and 39, the Examiner states that column 12, lines 22-23 of Kimura teaches a "parallel transcoding technique" that occurs "while input data that is currently being received by storage medium." Applicant respectfully traverses. Column 12, lines 22-23 of Kimura discloses a technique for re-recording already stored data. Therefore, there is no "*input data that is currently being received*," as claimed by Applicant.

The Examiner further concludes that "it would have been obvious . . . to have parallel transcoding for consuming time." Applicant assumes that the Examiner intended to say that parallel transcoding would *conserve* time. Applicant respectfully submits that a *general restatement of the advantages disclosed by the Applicant* deriving from implementation of the present invention cannot act as the required teaching or suggestion to combine cited references for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that "it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicants' structure as a template and selecting elements from references to fill in the gaps." In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

For at least the foregoing reasons, the Applicant submits that claims 19 and 39 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant

therefore respectfully requests reconsideration and withdrawal of the rejections of claims 19 and 39 under 35 U.S.C. § 103.

Amended Claims 8, 5, 17, 28, 35, and 37

Claims 8, 5, 17, 28, 35, and 37, as originally filed, presented certain limitations in the alternative. Applicants have herein amended claims 8, 5, 17, 28, 35, and 37, so that the foregoing limitations are no longer presented in the alternative. Applicants submit that newly-amended claims 8, 5, 17, 28, 35, and 37 contain a number of limitations and combinations that are not taught or suggested in the cited references. Applicants therefore respectfully request the Examiner to consider and allow amended claims 8, 5, 17, 28, 35, and 37, so that these claims may issue in a timely manner.

Summary

Applicant submits that the foregoing amendments and remarks overcome the Examiner's rejections under 35 U.S.C. §103(a). Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicant therefore submits that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-43, so that the present Application may issue in a timely manner. If there are any questions concerning this Response, the Examiner is invited to contact the Applicant's undersigned representative at the number provided below.

Respectfully submitted,

Date: 12/14/06

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